| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/280,609 | 03/29/1999 | DAVID BARCK | 6402 | 6090 |

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| EXAMINER |
|---|
| WILLETT, STEPHAN F |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2141 | |

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____3____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Jan 29, 2003* _____ .

2a) ☐ This action is **FINAL.**     2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-40* _____ is/are pending in the application.

   4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-40* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some* c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

   a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1.      This application currently names joint inventors.  In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary.  Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103©
and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains.  Patentability shall not be negatived by the
> manner in which the invention was made.

3.      Claims 1-11, 13, 21-25, 27-33 and 39-40 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Puri with Patent Number 6,064,982 in view of Raz with Patent Number
6,292,827

4.      Regarding claim(s) 1-11, 13, 21-25, 27-33 and 39-40, Puri teaches a product
configuration system over a LAN.  Puri teaches (a) interactively eliciting from a user on the at
least one client a desired subset of possible products having technical configurations as "the
smart configurator provides interactive, off-line product selection dialog in which a matrix of
company products is presented", col. 3, lines 54-56.  Puri teaches (b) in response to the user's

desired subset of possible products having technical configurations, downloading from the at

least one server to the at least one client limited configuration information and limited

configuration programs that is a subset as "various packaged options are available for selection

and/or individual components may be selected", col. 5, lines 52-53, a limited configuration

engine or interfaces or browser pages that merge user entered information, col. 2, lines 30-39,

col. 3, lines 24-46 and col. 5, lines 1-15. Puri teaches © interactively eliciting from the user on

the at least one client a desired technical configuration and preliminarily checking at the at least

one client the viability of the desired technical configuration using the limited configuration

information and the limited configuration programs as "the smart configurator determines the

appropriate hardware requirements to run the software in an acceptable fashion", col. 3, lines 63-

65. Puri teaches (d) uploading the desired technical configuration from the at least one client to

the at least one server and performing a full check on the viability of the desired technical

configuration using full configuration information and full configuration programs on the at least

one server as "the actual hardware requirements for particular software solution are automatically

determined by the smart configurator", col. 5, lines 63-65, "the smart configurator may be

optionally placed on-line to check for the existence of more current pricing and SKU information

at a company server, etc.", col. 4, line 16-21, 28-33 and col. 6, lines 46-52. Puri teaches (e)

responsive to the full check, preparing and outputting on the at least one client an electronic order

report as "the smart configurator provides a proposal template that merges various customer

related information into a generic proposal", col. 6, lines 20-22. Puri teaches the invention in the

above claim(s) except for explicitly teaching downloading a subset of an application. In that Puri

operates to generate configuration fields, the artisan would have looked to the network

configuration arts for details of implementing a user selections. In that art, Raz, a related

network configuration system, teaches "dynamic information transfer and management allowing

control or application intelligence and data content to be dynamically redistributed between data

servers and client terminals", col. 3, lines 32-35 in order to provide versatility. Raz specifically

teaches that "the intelligence that the client has at any moment varies according to the services

demanded by the user", col. 7, lines 32-33.  Further, Raz suggests that information "is either

processed locally on the transaction manager server, or a remote connection", col. 4, lines 28-30

will result from implementing his system. The motivation to incorporate dynamic applications

insures that the needed diversity is available. Thus, it would have been obvious to one of

ordinary skill in the art to incorporate program options as taught in Raz into the configuration

system described in Puri because Puri operates with diverse programs and Raz suggests that

optimization can be obtained.

5.      Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puri with

Patent Number 6,064,982 in view of Christeson et al. with Patent Number 5,926,817.

6.      Regarding claim(s) 1-11, 13, 21-25, 27-33 and 39-40, Puri teaches a product

configuration system over a LAN.  Puri teaches (a) interactively eliciting from a user on the at

least one client a desired subset of possible products having technical configurations as "the

smart configurator provides interactive, off-line product selection dialog in which a matrix of

company products is presented", col. 3, lines 54-56. Puri teaches (b) in response to the user's

desired subset of possible products having technical configurations, downloading from the at

least one server to the at least one client limited configuration information and limited

configuration programs that is a subset as "various packaged options are available for selection

and/or individual components may be selected", col. 5, lines 52-53, a limited configuration

engine or interfaces or browser pages that merge user entered information, col. 2, lines 30-39,

col. 3, lines 24-46 and col. 5, lines 1-15. Puri teaches © interactively eliciting from the user on

the at least one client a desired technical configuration and preliminarily checking at the at least

one client the viability of the desired technical configuration using the limited configuration

information and the limited configuration programs as "the smart configurator determines the

appropriate hardware requirements to run the software in an acceptable fashion", col. 3, lines 63-

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the at least one server and performing a full check on the viability of the desired technical

configuration using full configuration information and full configuration programs on the at least

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responsive to the full check, preparing and outputting on the at least one client an electronic order

report as "the smart configurator provides a proposal template that merges various customer

related information into a generic proposal", col. 6, lines 20-22. Puri teaches the invention in the

above claim(s) except for explicitly teaching desired technical configurations. In that Puri

operates to generate configuration fields, the artisan would have looked to the network

configuration arts for details of implementing a user selections. In that art, Christeson, a related

network configuration system, teaches an "the same applies to changes to access types and

service types", col. 4, lines 9-11 in order to provide versatility. Christeson specifically teaches

that "once the representative has completed entering all required fields and has selected the appropriate optional fields" at col. 6, lines 36-37. A user's selection of desired fields is possible and only viable alternatives are pursued. Further, Christeson suggests that "error messages are displayed with solutions", col. 4, lines 29 will result from implementing his system. The motivation to incorporate optional fields insures that only viable configurations are accepted. Thus, it would have been obvious to one of ordinary skill in the art to incorporate options viability as taught in Christeson into the configuration system described in Puri because Puri operates with selectable fields and Christeson suggests that optimization can be obtained with optional fields. Therefore, by the above rational, the above claims are rejected.

7.      Regarding claims 12, 34 and 36, Christeson teaches using a TCP/IP connection to pass an HTTP request from the client to the server as "such TCP/IP", col. 12, lines 14. Thus, the above claim limitations are obvious in view of the combination.

8.      Regarding claims 14, 15, 16, 20, 26 and 35-38, Puri teaches the limited configuration programs comprise an HTML page and client-side programs, the client-side programs comprise a plug-in or helper-application and the client-side programs include one or more programs selected from Java, JavaScript, ActiveX, and Helper-Viewer and CGIs as "dynamic HTML and JAVA script", col. 3, lines 13. Thus, the above claim limitations are obvious in view of the combination.

9.      Regarding claims 17, 18, 19 and, Christeson teaches the client-side programs are cached on the client, the client-side programs are cached in client-side memory and the client-side programs are cached in client-side disk storage as "removable storage unit, also called a program storage device or a computer program product, represents a floppy disk, magnetic tape, compact

disk, etc.", col. 14, lines 19-22. Thus, the above claim limitations are obvious in view of the combination.

### Response to Amendment

10.     The broad claim language, i.e. limited configuration engine, used is interpreted on its face and based on this interpretation the claims have been rejected.

11.     The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

12.     Applicant suggests "receiving a limited subset of all the functionality", Paper No. 12, Page 5, lines 4. The above argument is not commensurate with what is presently claimed and therefore will not be considered at this time. First, the applicant did not explain why the present claim language "is sufficiently clear to define the invention over" the references. In an effort to further prosecution, added "functionality" is also a very broad term that is met by providing updated data to an application, thus the usage of "configuration engine" is even broader, unless a lexicographic definition is provided in the specification and is included in the claims. An engine, with additional gasoline or configuration data has added functionality. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

13.     Applicant suggests "it is also undesirable in certain situations to pass the entire application to the client to allow the client to perform the entirety of the application on the client side", Paper No. 7, Page 1, lines 10-12, and/or contexts, and "repeated exchanges between the client and server are avoided", page 2, line 10. The above argument is not commensurate with what is presently claimed and therefore will not be considered at this time. Puri teaches a limited

configuration engine or interfaces or browser pages that merge user entered information, col. 2, lines 30-39, col. 3, lines 24-46 and col. 5, lines 1-15. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

14.     Applicant suggests "Puri teaches a system whereby all of the information and all the functionality is resident on the client side", Paper No. 7, Page 2, lines 19-20. This is correct but Puri's off-line capability is not mutually exclusive based on the teachings of Puri and what was reasonable based on the subject matter as a whole as would have been understood at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Specifically, Puri teaches "the user may use the tool in both an on-line setting and an off-line setting, col. 6, lines 51-53, but the information and capability may not be current, line 48, "the smart configurator may be optionally placed on-line to check for the existence of more current pricing and SKU information at a company server, etc.", col. 4, line 16-21, 28-33 and col. 6, lines 46-52, thus distributed data and applications are taught. In addition, Christeson clearly teaches obtaining configuration data on-line from various servers, col. 11, lines 32-44 as was well known. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

15.     Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the cited portions of the references with regard to Christeson and relevant portions of the reference.

## Conclusion

16.     The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. The other references cited teach numerous other ways to perform distributed processing between a client and server, thus a close review of them is suggested.
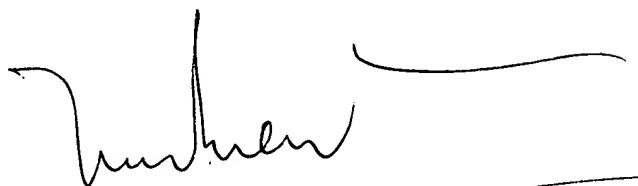
17.    Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

18.    If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

19.    Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

sfw

February 24, 2003

LE HIEN LUU
PRIMARY EXAMINER